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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,263	03/04/2002	Scott C. Nance	4248P2441	4043
23504	7590	11/21/2007	EXAMINER	
WEISS & MOY PC			LIN, SHEW FEN	
4204 NORTH BROWN AVENUE			ART UNIT	PAPER NUMBER
SCOTTSDALE, AZ 85251			2166	
MAIL DATE		DELIVERY MODE		
11/21/2007		PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 10/086,263

Filing Date: March 04, 2002

Appellant(s): NANCE, SCOTT C.

NOV 20 2007

Technology Center 2100

Veronica-Adele R. Cao
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 16, 2007 appealing from the Office action mailed May 27, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed. However, the claims filed after final, on August 26, 2005, is the claims filed before November 4, 2004. The last office action is based on the claims filed on November 4, 2004.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6173045 B1	Smith; James Oval	Issued on 1/9/2001
US 5901214 A	Shaffer; James D. et al.	Issued on 5/4/1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, US 6,173,045, 9 January 2001 and Shaffer et al (Shaffer), US 5,901,214, 4 May 1999.

Smith is directed to an electronic phone book as an improvement and adjunct to the prior art of printed telephone books [COL 1 lines 12-19]. Smith does not explicitly address the type of telephone service, such as the use of cellular or wireless phones, but does provide for access in an embodiment that is directly accessible from a phone [COL 2 lines 20-36]. Alternately, the phone book may be an integral unit of the phone or reside on a CD-Rom drive [COL 2 lines 51-65]. Further, the phone book may communicate with a central repository [COL 2 line 66 to COL 3 line 4]. These embodiments as a whole suggest that any phone access will support the system.

Shaffer is directed to an intelligent call processing system that involves databases and directories [ABSTRACT; COL 2 lines 7-25; COL 3 line 42 to COL 5 line 30]. As one example, Shaffer teaches the use of a reverse directory search [COL 5 lines 5-14], which is clearly a variation of (standard) directory search. As another, Shaffer teaches the use of directory assistance [COL 21 lines 32-35].

Shaffer is not explicit in his treatment of alphabetical indexing, phone books, CD- Rom publishing, and the like, but does make it clear that his system applies to cellular phones [COL 7 lines 43-46]. The system of Shaffer uses Local Exchange Routing Guide (LERG) files and their derivatives [COL 21 line 60 to COL 22 line 4 and elsewhere throughout].

Shaffer teaches that one source of telephone number changes is Bellcore and that this information is published and publicly available [COL 21 lines 51-59]. Of particular interest here is the teaching of Shaffer that cellular numbers are simply distinguished by a telephone code type and thus the cellular aspect of directory use of the number is moot [COL 43 lines 22-44]. This suggests that directory assistance, such as that provided by a phone book, is not fundamentally different for phone service of differing types, such as for cellular phone services.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teaching of Shaffer that cellular phone use is not fundamentally distinct from other phone use with respect to directory and database service to the system of Smith because to do so would greatly extent the applicability and utility of Smith's telephone book.

As to claim 1, lists of telephone numbers are generated by phone service providers, as noted by Shaffer [COL 21 lines 51-59], no other source can provide an essentially complete list, and thus those numbers of cellular type are provided by a cellular phone provider. Telephone

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books that include cellular phone users correspond to compiling a list of cellular phone users from at least one cellular phone provider, and a list of corresponding cellular phone numbers of said cellular phone users.

Such lists are maintained in a database [Smith COL 3 line 66 to COL 4 line 11]. The database is published variously in a phone book [Smith COL 1 lines 12-14], CD- Rom [Smith COL 2 lines 56-64], or made available through a network [Smith FIG 2; COL 2 lines 45-52].

It is inherent in the definition of a database that users search it, and this is taught explicitly by Smith at COL 1 lines 64-67.

As to claim 2, Smith provides for alphabetical lookup [COL 3 lines 41-49].

As to claim 6, Smith teaches the use of advertisement in telephone books, and it is inherent in the use of such advertisements that their purpose is to generate revenue.

As to claim 7, Smith and Shaffer do not explicitly state that separate directories are created for separate cellular phone providers. However, the information available to a provider is the database of their own subscribers, and the subscribers to other services are not available to a provider until published. Thus at some level of access, it is necessary for separate providers to separately publish lists of subscribers. Further, there are economic motivations within the knowledge of one of ordinary skill in the art for a provider to not publish the list of subscribers to other services.

For instance, supporting access to one's own subscribers with a dedicated phone directory clearly creates a community of access that would tend to promote subscriptions within the community because access is made easier by that directory.

As to claim 8, Official Notice is taken that at the time of the invention, it was well known to provide phone books services independently of phone providers, both "yellow pages" and "white pages".

The elements of this claim correspond to the creation of such a phone book in a manner that has no requirements specifically dependent on whether or not the phone service is cellular.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a multi-provider phone book for cellular services for the same reasons that they are provided for other phone services. It is clearly a commercially viable operation from the history of phone books, and of use to subscribers.

As to claim 9, Official Notice is taken that the use of unlisted numbers was well known at the time of the invention, and supported by numerous motivations. The elements of the claim correspond to providing for unlisted numbers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide for unlisted cellular numbers because subscribers desire them. One motivation is the charges for incoming calls to cellular phones.

As to claims 11-12, Shaffer is directed to VOIP (voice operated) directory services [ABSTRACT and elsewhere throughout], as an improvement on person- operated directory and answering services [BACKGROUND and elsewhere throughout].

As to claims 13-15, Smith provides for downloading at least in part onto a local device [FIG 3a-3f], and certainly downloading to a CD-Rom corresponds to downloading to a computer. Official Notice is taken that downloading data to a cellular phone and/or to a PDA

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was well known in the art at the time of the invention. The name of data (alphabetical directory in this case) is not a patentable limitation.

The elements of **claims 3-5, 10 and 16-23** are rejected in the analysis above and these claims are rejected on that basis.

(10) Response to Argument

This Examiner's Answer will address the arguments in the order in which they appear in the appeal brief.

Argument (1): Smith fails to provide any information that would render obvious Applicant's method for a cellular or wireless type provider to either compile or make publicly accessible a searchable database or users. Instead, the operation of the device of Smith presupposes the existence of a database by a telephone provider. Although cellular or wireless type phone numbers were well known at the time of Smith, Smith does not teach, disclose, or suggest that the device may be used to locate such numbers

In response to argument (1): First, it is noted that the features upon which Applicant's argument relies (i.e., a cellular or wireless type provider to either compile or make publicly accessible a searchable database or users) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the list of cellular phone users/numbers can be compiled by any users or third party other than cellular phone provider, as cited in the claim, "compiling a list of cellular phone users from

at least one cellular phone provider". Second, as noted in the cited passage of the rejection, Smith discloses a system to compile and retrieve telephone number from database and database can be either located locally (local drive 16 and 18) or remotely (central office database), see Figure 2, column 2, line 66 to column 3, line 4. Smith does not explicitly disclose that the telephone number could be any cellular phone number, it was Shaffer that was used to support that the phone number stored in the database could be the numbers of cellular phone and pagers (see Shaffer, column 7, lines 43-46).

Argument (2): Although the system of Schaffer is sufficiently flexible to incorporate cellular phone numbers, Schaffer, like Smith, presupposes the existence of a publicly accessible, searchable database of cellular numbers and users in order to incorporate such data. Shaffer in no way teaches how such a database may be compiled from a cellular service provider data and made publicly available, and therefore cannot render Applicant/s claimed invention obvious.

In response to argument (2): First, As noted in the argument (1), Smith teaches a searchable database for the telephone number (see Smith, Figure 2) and Schaffer teaches a virtual telephone number database that including cellular and page numbers (see Schaffer, abstract, column 38, lines 54-59, The preferred file for classifying a telephone number is a V&H Coordinate file 356. For each valid NPANXX, this file contains the type of service provided, e.g., POTS, cellular, pager, and so forth). The combination of Smith and Schaffer teaches the limitation, "a database may be compiled from a cellular service provider data". Second, the claims, such as claim 1, do not include the limitation publicly. Third, the actual claim language also provides no mechanism for compiling the source data, merely accessing a list of (cellular)

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phone numbers. Fourth, the claims, such as claim 1, could be entirely carried out within the organization of a cellular phone provider. Alternately, the list could itself be a (published) public database of cellular phone numbers and satisfy the claims. Fifth, one of ordinary skill at the time of the invention would be well aware that the modifier cellular with respect to phone numbers is nonfunctional description; such numbers have exactly the same format as other phone numbers. Finally, it is noted that a line phone number can be reached from a cellular phone and vice versa, so any source of data reachable by one is reachable by the other.

Argument (3): In order for the Claims to be properly rejected as being obvious in light of the combination of Smith and Schaffer, the prior art references must suggest the desirability of the combination.

In response to argument (3): First, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Second, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Shaffer and Smith because the references are concerned with accessing telephone numbers from database, and by including the cellular or page numbers as disclosed in Shaffer, to reduce the waste involved in yearly updates to the telephone book and to provides more advanced searching capabilities (see Smith, column 1, lines 40-43). It is for this reason that one of ordinary skill in the art would have been motivated to

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include cellular and non-cellular phone numbers to greatly extent the applicability and utility of Smith's telephone book.

Argument (4): Although the Examiner asserts that it would be obvious to generate a directory of cellular numbers, each cited reference fails to demonstrate the existence of such a directory or to teach how such a directory may be compiled or published.

In response to argument (4): First, the actual claim language provides no mechanism for compiling the source data, merely accessing a list of (cellular) phone numbers. Second, Smith discloses an electronic telephone book replaces the telephone directory and yellow pages by retrieving information from the telephone company's central office, searching can be done electronically on a number of fields such as name, category or keywords, thereby providing a more accurate listing of yellow page advertisers (column 1, lines 56-76). It clearly indicated that the directory is compiled by the telephone company (phone provider) accessible by user through phone line. In addition, Smith discloses users can compile lists of users and associated phone numbers by retrieving information from the central office and stored in the local drives (Figure 3a-3f, column 3, lines 1-4, the electronic telephone book 10 may retrieve information from the central office, such as phone numbers and advertisements, and may update information stored in the local drives 16 and 18, column 4, lines 9-11, When the Select button 90 is pressed, the highlighted name will be entered into the user's local database of telephone numbers (in this case, the "Friends" database)).

Argument (5): Applicant acknowledges that both cellular and non-cellular numbers each comprise ten digits, and therefore Applicant's claimed invention may potentially be practiced using elements taken from non-cellular directory assistance technology. The similarity between the number of digits in cellular and non-cellular phone numbers is no more than coincidental. Applicant also notes that the existence of substantial distinctions between traditional and cellular or wireless type services, such as different underlying technologies and infrastructures, business models, markets and market forces, subscriber characteristics and expectations, governmental regulation, and the culture and tradition of the two service types, to name only a few.

In response to argument (5): First, it should be noted that the underlying technologies and infrastructures for the cellular phone is not recited in the claim limitation and is irrelevant. Furthermore, compiling and publishing a phone number database from a list of phone numbers does not require any distinction between cellular and non-cellular phone numbers, nor are any of the steps of the claims directed to such differences, if they exist. Second, as Applicant admitted that Applicant's claimed invention may potentially be practiced using elements taken from non-cellular directory assistance technology. Third, as noted above, a line phone number can be reached from a cellular phone and vice versa, so any source of data reachable by one is reachable by the other, there is no distinct utility between a cellular phone number and a non-cellular phone number. The difference is simply a rearrangement of non-functional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. (Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Shew-fen Lin
Examiner AU 2166

November 19, 2007

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